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PATENT APPLICATION

ATTORNEY DOCKET NO. _____200208247-1_____

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Brian L. Patterson	Confirmation No.: 4878
Application No.: 10/767,356	Examiner: Sensenig, Shaun D.
Filing Date: 01/28/2004	Group Art Unit: 4176

Title: Transaction Based Storage System

Mail Stop Appeal Brief-Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on _____12/04/2008_____.

☒ The fee for filing this Appeal Brief is $540.00 (37 CFR 41.20).

☐ No Additional Fee Required.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

☐(a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d)) for the total number of months checked below:

☐ 1st Month $130	☐ 2nd Month $490	☐ 3rd Month $1110	☐ 4th Month $1730

☐ The extension fee has already been filed in this application.

☒(b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account 08-2025 the sum of _____$ 540_____. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees.

Respectfully submitted,

Brian L. Patterson

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Serial No. 10/767,356
Confirmation No. 4878
Filing Date 01/28/2004
Inventorship .... Brian L. Patterson
Group Art Unit..4176
Examiner .... Sensenig, Shaun D.
Attorney's Docket No. 200208247-1
Title: Transaction Based Storage System

APPEAL BRIEF

To: Commissioner for Patents
       P.O. Box 1450
       Alexandria, VA 22313-1450

Sir:

       This Appeal Brief is submitted in response to the final rejections of the claims mailed
October 27, 2008. A Notice of Appeal is filed herewith.

REAL PARTY IN INTEREST

       The assignee of the entire right, title, and interest in the patent application is Hewlett-
Packard Development Company.

RELATED APPEALS AND INTERFERENCES

       There are currently no related appeals of other United States patent applications known to
Appellants, Appellants' legal representative, or the assignee that will directly affect, or be
directly affected by, or have a bearing on, the Board's decision. There are currently no related
interferences known to Appellants, Appellants' legal representative, or the assignee which will
directly affect, or be directly affected by, or have a bearing on, the Board's decision.

STATUS OF CLAIMS

Claims 1-13 and 35-47 are pending in this application.

No Amendments have been submitted in response to the final Office Action. Thus, the status of the claims is as follows:

Claims 1-7, 9-13, 35-41, and 43-47 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent Publication No. 2002/0091645 to Tohyama, et al. (hereinafter "Tohyama").

Claims 8 and 42 stand rejected under 35 U.S.C. §103(a) as being obvious over Tohyama, et al. in view of U.S. Patent Publication No. 2002/0069148 to Mutschler, et al. (hereinafter "Mutschler").

STATUS OF AMENDMENTS

No Amendments have been submitted in response to the final Office Action.

SUMMARY OF CLAIMED SUBJECT MATTER

The subject matter of the independent claims is summarized below with reference numerals and reference to the specification and drawings in accordance with 37 CFR §41.37.

Independent Claim 1

Independent claim 1 is directed to a method of computing. In one embodiment, at a processor in a storage network a service request is received from a user of the storage network (Fig. 8, reference numeral 810; paragraph [0054] at page 20, lines 10-20), an amount of credit available on a local media is determined for the user of the storage network (Fig. 8, reference numeral 815; paragraph [0056] at page 21, lines 5-18), and the service request is implemented at the processor when the amount of credit is sufficient to execute the service request (Fig. 8, reference numeral 855; paragraph [0056] at page 21, lines 5-18). By contrast, when the amount of credit is insufficient to execute the service request, in response to the received service request, a token request for a service token is generated (Fig. 8, reference numeral 820; paragraph [0057] at page 21, line 19 through page 22, line 7) and transmitted to a server communicatively connected to the storage network (Fig. 8, reference numeral 825; paragraph [0057] at page 22, lines 8-18). At the server, the token request is validated (Fig. 8, reference numeral 830; paragraphs [0059]-[0061] at page 22, line 19 through page 23, line 22) and a response to the validated token request is transmitted to the processor (Fig. 8, reference numeral 835; paragraphs [0062]-[0063] at page 22, lines 1-19). Further, at the processor in the storage network the service request is invoked when the response to the token request includes at least one service token (Fig. 8, reference numeral 855; paragraphs [0064]-[0065] at page 24, line 20-page 25, line 15).

Independent claim 35 is directed to a storage system. In one embodiment, the system comprises a local controller comprising a processor an a memory module, wherein the memory module comprises logic instructions which, when executed by the processor, configure the processor to receive a service request from a user of the storage network (Fig. 8, reference numeral 810; paragraph [0054] at page 20, lines 10-20), determine an amount of credit available on a local media for the user of the storage network (Fig. 8, reference numeral 815; paragraph [0056] at page 21, lines 5-18), implement the service request at the processor when the amount of credit is sufficient to execute the service request (Fig. 8, reference numeral 855; paragraph [0056] at page 21, lines 5-18), and when the amount of credit is insufficient to execute the service request, to generate, in response to the received service request, a token request for a service token (Fig. 8, reference numeral 820; paragraph [0057] at page 21, line 19 through page 22, line 7) and transmit the token request to a server communicatively connected to the storage network (Fig. 8, reference numeral 825; paragraph [0057] at page 22, lines 8-18). The storage system further comprises a remote server coupled to the local controller comprising a processor an a memory module, wherein the memory module comprises logic instructions which, when executed by the processor, configure the processor to: validate the token request (Fig. 8, reference numeral 830; paragraphs [0059]-[0061] at page 22, line 19 through page 23, line 22), and transmit to the processor a response to the validated token request (Fig. 8, reference numeral 835; paragraphs [0062]-[0063] at page 22, lines 1-19); wherein the processor invokes the service request when the response to the token request includes at least one service token (Fig. 8, reference numeral 855; paragraphs [0064]-[0065] at page 24, line 20-page 25, line 15).

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Whether claims 1-7, 9-13, 35-41, and 43-47 are properly rejected under 35 U.S.C. §102(b) as being anticipated by Tohyama.

2. Whether claims 8 and 42 are properly rejected under 35 U.S.C. §103(a) as being obvious over Tohyama in view of Mutschler.

ARGUMENT

I. Rejections Under 35 U.S.C. §102

      A. Legal Standard for Anticipation

      The standard for lack of novelty, that is, for anticipation, under 35 U.S.C. §102 is one of *strict identity*. To anticipate a claim for a patent, a single prior source must contain all its essential elements. *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 231 USPQ 81, 90 (Fed. Cir. 1986). Invalidity for anticipation requires that all of the elements and limitations of the claims be found within a single prior art reference. *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 USPQ2d 1001 (Fed. Cir. 1991). Every element of the claimed invention must be literally present, arranged as in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). "The *identical* invention must be shown in as complete detail as is contained in the patent claim." MPEP §2131 (7th Ed. 1998) (citing *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). Furthermore, functional language, preambles, and language in "whereby," "thereby," and "adapted to" clauses cannot be disregarded. *Pac-Tec, Inc. v. Amerace Corp.*, 14 USPQ2d 1871 (Fed. Cir. 1990).

      "It is by now well settled that the burden of establishing a *prima facie* case of anticipation resides with the Patent and Trademark Office." *Ex parte Skinner*, 2 USPQ2d 1788, 1788-1789 (Bd. Pat. Int. 1986) (holding that examiner failed to establish *prima facie* case of anticipation). The examiner has "the burden of proof . . . to produce the factual basis for its rejection of an application under sections 102 or 103." *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984) (quoting *In re Warner*, 379 F.2d 1011, 1016, 154 USPQ 173, 177 (CCPA 1967)). Only if that burden is met, does the burden of going forward shift to the appellant.

1. Claims 1 and 35

Tohyama cannot anticipate (or render obvious) independent claim 1 because Tohyama neither discloses (nor even suggests) limitations recited in independent claim 1. Claim 1 is directed to a method computing. The method recites limitations directed to:

> at a processor in a storage network:
>> receiving a service request from a user of the storage network;
>> determining an amount of credit available on a local media for the user of the storage network;
>> implementing the service request at the processor when the amount of credit is sufficient to execute the service request; and
>> when the amount of credit is insufficient to execute the service request:
>>> generating, in response to the received service request, a token request for a service token; and
>>> transmitting the token request to a server communicatively connected to the storage network; and
>> at the server:
>>> validating the token request;
>>> transmitting to the processor a response to the validated token request; and
>> at the processor in the storage network:
>>> invoking the service request when the response to the token request includes at least one service token.

The final Action asserts that Tohyama discloses determining an amount of credit available on a local media for the user of the storage network, and cites paragraph [0049] to support the rejection. Applicants disagree. The cited text reads as follows:

> [0049] In the user account database 3b, there is stored a "user account" such as shown in FIG. 2; and writing thereto, reading therefrom and the like are managed by the above-mentioned license management program 3a. In the user account, there is registered a "user ID (UserID)" for each user, and in each user ID there are stored "user data (UserInfo)" and "license data (License)". The user data is information which the user himself inputs upon user registration, in which there is stored data such as "first and last name", "address", "telephone number", "email address" and credit card number or other such "charging information". As the license data, there is given an "application ID (AppID)" for specifying the software (i.e., including such content as the software in its entirety, a partial functional program of the software, image data that can be used with the software, musical data or the like) which is approved for use with respect to each user, and for each application ID there are stored a "license base (LicenseBase)" and a "license

validity (LicenseValidity)".

Contrary to the assertion in the Action, nothing in this text discloses (nor even suggests) determining an amount of credit available on a local media for the user of the storage network, as recited in claim 1.

The final Action further asserts that Tohyama discloses implementing the service request at the processor when the amount of credit is sufficient to execute the service request, and cites paragraphs [0049] and [0053] to support the rejection. Applicants disagree. Paragraph [0049] is excerpted above. Paragraph [0053] reads as follows:

> [0053] In the application information database 3c, there is stored information pertaining to the license conditions for the software of which usage is approved, such as is shown in FIG. 5. Specifically, for each "application ID (AppID)" there is registered the "license menu (LicenseMenu)". The registration is performed by the supplier terminals 1, 2 accessing the license management server machine 3 via the internet network, as described above. Note that here, even when registration is made for the same software (for example, in the case of registering "a-1" and "a-2" which both contain "a" in the software ID), it is possible to register a plurality of license menus therefor, according to the content of the usage approval (i.e., a function program in "a-1", and contents such as image data in "a-2". Further, even in the case when the content of the usage approval is the same for the same software (for example, "c-1" and "c-1"), it is possible to register a plurality of license menus according to the time elements of the usage-approval ("perpetual" in the top "c-1" and the calendar period in the bottom "c-1"). This configuration is adopted in order to provide a variety of licensing menus to meet various needs of users--including a user who basically wants usage-approval for the entire software, a user who only wants usage-approval for a partial functional program of the software, a user who wants usage-approval for only a predetermined period of time, for example--even for the same single software. A "license condition name" included in the license menu of FIG. 5 is a name for distinguishing the license conditions (content) for the software is to be usage-approved. A "license term/number of times of use" is data indicating the time element of the license, in which the software provider sets "perpetual", "calendar period" "total duration of time of use" or "total number of times of use" for each application ID. A "license fee" is a monetary amount, and a "charging method", which is a method of payment thereof, is also selected and set by the software supplier. Further, in the "pass issuance regulations", "regulations pertinent at time of purchase" -stipulates a type of pass which is to be issued, and "regulations pertinent at time of renewing" stipulates how the renewing of the pass should be processed according to the charging status. The "temporary pass term and number of times of use" and the "pass term and number of times of use" stipulate how to adjust the remaining amount of the license validity at the time of renewal of the license validity and at the time of renewal of the pass.

Contrary to the assertion in the Action, nothing in this text discloses (nor even suggests) implementing the service request at the processor when the amount of credit is sufficient to execute the service request, as recited in claim 1.

The final Action further asserts that Tohyama discloses generating, in response to the received service request, a token request for a service token, transmitting the token request to a server communicatively connected to the storage network, validating the token request, transmitting to the processor a response to the validated token request, and invoking the service request when the response to the token request includes at least one service token, and cites paragraph [0009] to support the rejection. Applicants disagree. Paragraph [0009] reads as follows:

> [0009] According to the present invention, in order to achieve the above objects, there is provided a software licensing system comprising: a licensing terminal for storing a license menu which includes a function, a term and a number of times and the like, for which usage may be approved with respect to a software for which usage approval is to be given; and a user terminal capable of accessing the license menu via a communications line; wherein when the licensing terminal creates and sends to the user terminal a pass containing the function, the term and the number of times and the like for which usage is to be approved based on an agreement/selection by the user terminal, the user terminal then sends, to the software for which the usage approval is to be given, a run-approval or a run-disapproval command data according to information on the function, the term and the number of times of use and the like contained in the received pass, and the user terminal then becomes able to use the software in a manner in conformity with the content of the usage approval in the pass created by the license terminal..

Contrary to the assertion in the Action, nothing in this text discloses (nor even suggests) generating, in response to the received service request, a token request for a service token, transmitting the token request to a server communicatively connected to the storage network, validating the token request, transmitting to the processor a response to the validated token request, and invoking the service request when the response to the token request includes at least one service token, as recited in claim 1.

In sum, the Action includes erroneous factual findings with respect to the scope and content of the prior art. Accordingly, the rejections are improper.

Claim 35 was rejected on the same basis as claim 1. Applicant traverses the rejection of claim 35 based on the same argument applied to claim 1.

2. Claims 3 and 37

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Dependent claim 3 depends from, and further defines over and above claim 1 by reciting:

> wherein the service request comprises a request for at least one of a data mirroring service, a remote copy service, a back-up service, a recovery service, or a LUN extension service.

The final Action asserts that Tohyama discloses these limitations, and cites paragraphs [0009] to support the rejection. Applicants disagree. Paragraph [0009] is excerpted above. Contrary to the assertion in the Action, nothing in Tohyama discloses (nor even suggests) an arrangement wherein the service request comprises a request for at least one of a data mirroring service, a remote copy service, a back-up service, a recovery service, or a LUN extension service, as recited in claim 3. Therefore, Tohyama cannot anticipate claim 3.

Claim 37 was rejected on the same basis as claim 3. Applicant traverses the rejection of claim 37 based on the same argument applied to claim 3.

3. Claims 4 and 38

Dependent claim 4 depends from, and further defines over and above claim 1 by reciting:

> wherein generating a token request comprises retrieving at least one account identifier for an account associated with a device in the storage network.

The final Action asserts that Tohyama discloses these limitations, and cites paragraph [0009] and [0124] to support the rejection. Applicants disagree. Paragraph [0009] is excerpted above. Paragraph [0124] reads as follows:

[0124] At the license management server machine 3, the license management program 3a reads, from the user account database 3b, the license validity in the license data that corresponds to the application ID "a-1" in the received portable pass "1" and the user ID "3", which are received (s126), and verifies whether the license validity is in the "Currently Being Moved" state or not (s218). In this judgment, the license validity is judged to be in the "Currently Being Moved" state only in the case when the following three conditions are met: the "remaining amount of the license" contained in the license validity has a value greater than zero, the "license status" has a "Valid" value, and the

"pass status" has the "Currently Being Moved" value. Here, for the application ID "a-1", the "remaining amount of the license" is still unused and indicates "perpetual", the "license status" is "Valid" and the "pass status" has been updated to the "Currently Being Moved" state at step 174 in FIG. 12; therefore, the license validity is judged to be "Currently Being Moved". Therefore, the license management program 3a duplicates the "pass status" and the "remaining amount of the pass" in the license validity of the portable pass "1", and combines these with the application ID "a-1" to make the pass "1" (s222). Next, the license management program 3a replaces the "pass status" in the license validity which has been read out with a value indicating "Valid", updates the license validity (s224), and saves to the user account database 3b (s226). Further, the pass "1" created at step 222 is sent to the user terminal 6 (s228).

Contrary to the assertion in the Action, nothing in Tohyama discloses (nor even suggests) an arrangement wherein generating a token request comprises retrieving at least one account identifier for an account associated with a device in the storage network, as recited in claim 4. Therefore, Tohyama cannot anticipate claim 4.

Claim 38 was rejected on the same basis as claim 4. Applicant traverses the rejection of claim 38 based on the same argument applied to claim 4.

4. Claims 5 and 39

Dependent claim 5 depends from, and further defines over and above claim 1 by reciting:

> wherein generating a token request comprises incorporating into the token request information identifying the service request.

The final Action asserts that Tohyama discloses these limitations, and cites paragraphs [0009] to support the rejection. Applicants disagree. Paragraph [0009] is excerpted above. Contrary to the assertion in the Action, nothing in Tohyama discloses (nor even suggests) an arrangement wherein generating a token request comprises incorporating into the token request information identifying the service request, as recited in claim 5. Therefore, Tohyama cannot anticipate claim 5.

Claim 39 was rejected on the same basis as claim 5. Applicant traverses the rejection of claim 39 based on the same argument applied to claim 5.

Dependent claim 6 depends from, and further defines over and above claim 5 by reciting:

> wherein generating a token request comprises incorporating into the token request information identifying the service request.

The final Action asserts that Tohyama discloses these limitations, and cites paragraphs [0009] to support the rejection. Applicants disagree. Paragraph [0009] is excerpted above. Contrary to the assertion in the Action, nothing in Tohyama discloses (nor even suggests) an arrangement wherein generating a token request comprises incorporating into the token request information identifying the service request, as recited in claim 6. Therefore, Tohyama cannot anticipate claim 6.

Claim 40 was rejected on the same basis as claim 6. Applicant traverses the rejection of claim 40 based on the same argument applied to claim 6.

6. Claims 7 and 41

Dependent claim 7 depends from, and further defines over and above claim 5 by reciting:

> wherein validating the token request comprises determining whether the account associated with the at least one account identifier comprises sufficient credit to receive a token.

The final Action asserts that Tohyama discloses these limitations, and cites paragraph [0051] to support the rejection. Applicants disagree. Paragraph [0051] reads as follows:

> [0051] Further, in the license validity, there is included data pertaining to the current license status regarding each application ID. Namely, this is respective data of a "remaining amount of the license", the "license status" and the "pass status", which are shown in FIG. 4. Among these, data to be written in the "remaining amount of the license" is comprised of the following: the "x" in the case where the usage-approval for the application ID is "perpetual"; a start date and time, and an end date and time in the case when the usage-approval is for the "calendar" period; a total remaining duration of time in the case when the usage-approval is for the "total duration of time of use"; and a remaining number of times of use in the case where the usage-approval is for the "total number of times of use". Further, the license status is composed of data indicating whether the license is valid or not, in accordance with actual

performance of a payment for the charge applied.

Contrary to the assertion in the Action, nothing in Tohyama discloses (nor even suggests) an arrangement wherein validating the token request comprises determining whether the account associated with the at least one account identifier comprises sufficient credit to receive a token, as recited in claim 7. Therefore, Tohyama cannot anticipate claim 7.

Claim 41 was rejected on the same basis as claim 7. Applicant traverses the rejection of claim 41 based on the same argument applied to claim 7.

8. Claims 9 and 43

Dependent claim 9 depends from, and further defines over and above claim 1 by reciting:

> wherein the response to the token request comprises at least one of:
> an account identifier;
> an account balance;
> a code, decipherable by the processor, granting or denying permission to invoke the service call; and
> a software module, executable by the processor, for invoking the service call.

The final Action asserts that Tohyama discloses these limitations, and cites paragraphs [009] and [0124] to support the rejection. Applicants disagree. The cited text is excerpted above. Contrary to the assertion in the Action, nothing in the cited text discloses (nor even suggests) an arrangement wherein the response to the token request comprises at least one of: an account identifier, an account balance, a code, decipherable by the processor, granting or denying permission to invoke the service call, and a software module, executable by the processor, for invoking the service call, as recited in claim 9. Therefore, Tohyama cannot anticipate claim 9.

Claim 43 was rejected on the same basis as claim 9. Applicant traverses the rejection of claim 43 based on the same argument applied to claim 9.

9. Claims 11 and 45

Dependent claim 11 depends from, and further defines over and above claim 1 by reciting:

> wherein the response to the token request comprises a software module, executable by the processor, for invoking the service call.

The final Action asserts that Tohyama discloses these limitations, and cites paragraph [0014], [0048], and [0086] to support the rejection. Applicants disagree. The cited text reads as follows:

> [0014] Further, the computer program and the recording medium according to the present invention are constructed as a computer program and computer readable recording medium for storing the program, which computer program executes the following by means of a control means of the licensing terminal which can connect via the communications line to the user terminal that uses the software for which usage approval has been given and which stores the license menu containing the function, the term and the number of times and the like for which usage may be approved for the software: processing (a) being processing for sending to the user terminal a license menu that pertains to the software; processing (b) being processing for receiving agreement/selection data that contains the function, the term and the number of times and the like that the user terminal agreed/selected from the license menu, and creating the pass that contains information on the function, the usage period and the like for which usage is to be approved for the software, based on the agreement/selection data; and processing (c) being processing for sending the pass to the user terminal.

> [0048] The license management server machine 3 is the core of the licensing system of the present example; as such, a license management program 3a, which is executed by the CPUs that serve as the control means (not shown), accesses a provided user account database 3b and application information database 3c, and carries out communications controls with the supplier terminals 1 and 2 and the user terminal 4.

> [0086] The license controller 4a judges whether the received pass "1" is valid or not (s52, s54). In this validity judgment, the judgment of "Valid" is made only in the case where the pass status of the pass "1" of FIG. 8(a) indicates "Valid", and the remaining amount of the pass still has some amount remaining. It is being assumed, here, that the pass status of the pass "1" is "Valid", and that the remaining amount of the pass is "-(perpetual)", so the pass "1" is valid. Therefore, the license controller 4a creates command data to approve the running of the application ID "a-1" contained in the pass "1", and sends this to the software installed in the user terminal 4 (s56). Accordingly, the user terminal 4 can now use the function program of the application ID "a-1", which could not be used previously for the software.

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Contrary to the assertion in the Action, nothing in Tohyama discloses (nor even suggests) an arrangement wherein the response to the token request comprises a software module, executable by the processor, for invoking the service call, as recited in claim 11. Therefore, Tohyama cannot anticipate claim 11.

Claim 45 was rejected on the same basis as claim 11. Applicant traverses the rejection of claim 45 based on the same argument applied to claim 11.

10. Claims 12 and 46

Dependent claim 12 depends from, and further defines over and above claim 11 by reciting:

> wherein the processor in the storage network:
> receives the response to the token request; and
> executes the software module to invoke the service request.

The final Action asserts that Tohyama discloses these limitations, and cites paragraphs [0086] to support the rejection. Applicants disagree. The cited text is excerpted above. Contrary to the assertion in the Action, nothing in the cited text discloses (nor even suggests) an arrangement wherein the processor in the storage network receives the response to the token request, and executes the software module to invoke the service request, as recited in claim 12. Therefore, Tohyama cannot anticipate claim 12.

Claim 46 was rejected on the same basis as claim 12. Applicant traverses the rejection of claim 46 based on the same argument applied to claim 12.

8. Claims 13 and 47

Dependent claim 9 depends from, and further defines over and above claim 1 by reciting:

> wherein the processor maintains account information associated with
> one or more storage devices, and wherein the processor updates account
> information to reflect execution of the service request.

The final Action asserts that Tohyama discloses these limitations, and cites paragraph [0124] to support the rejection. Applicants disagree. The cited text is excerpted above. Contrary to the assertion in the Action, nothing in the cited text discloses (nor even suggests)

an arrangement wherein the processor maintains account information associated with one or more storage devices, and wherein the processor updates account information to reflect execution of the service request, as recited in claim 13. Therefore, Tohyama cannot anticipate claim 13.

Claim 47 was rejected on the same basis as claim 13. Applicant traverses the rejection of claim 47 based on the same argument applied to claim 13.

II. Rejections Under 35 U.S.C. §103

A. Legal Standard for Obviousness

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest *all* the claim limitations. (*See, MPEP § 2143*). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Moreover, all words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

As with anticipation, the Examiner bears the burden of proof to provide a factual basis to support a rejection under 35 U.S.C. §103. *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984) (quoting *In re Warner*, 379 F.2d 1011, 1016, 154 USPQ 173, 177 (CCPA 1967)). Only if that burden is met, does the burden of going forward shift to the Appellant.

B. Tohyama, Alone or in Combination with Mutschler, Fails to Disclose Elements Recited in Claims 8 and 42

Claims 8 and 42 were rejected under 35 U.S.C. §103(a) as being obvious over Tohyama in view of Mutschler. Applicants traverse these rejections.

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Initially, Applicant contends that the Action fails to establish a prima facie case of obviousness because the Action fails to make the necessary factual findings required under Teleflex Inc. v. KSR Int'l, Co. 550 U.S. ___, 82 USPQ 2d 1385 (2007), as interpreted by the Examination Guidelines for Determining Obviousness Under 35 U.S.C. §103 in View of the Supreme Court Decision in KSR International Co. v. Teleflex Inc., published October 10, 2007. For example, the Action lacks any factual findings with regard to on the level of ordinary skill in the art.

Further, Applicants assertthat the Action fails to establish a *prima facie* case of obviousness because there are errors in the factual findings regarding the scope and content of the prior art underlying the obviousness rejection. .

Dependent claim 8 depends from, and further defines over and above claim 7 by reciting:

> further comprising retrieving information from a third-party credit bureau.

Contrary to the assertion in the final Action, nothing in Tohyama discloses (nor even suggests) the limitations in claims 7, 5, 4, and 1, from which dependent claim 8 depends. Therefore, Tohyama, alone or in combination with Mutschler, cannot render obvious claim 8.

Claim 42 was rejected on the same basis as claim 8. Applicant traverses the rejection of claim 42 based on the same argument applied to claim 8.

CONCLUSION

The cited references fail to disclose or suggest limitations of appellants' claims. Therefore, the cited cannot be used to establish the required *prima-facie* case of anticipation under 35 U.S.C. §102 or of obviousness under 35 U.S.C. §103 . Accordingly, Appellants urge the Board to reverse the examiner's rejections of the pending claims.

Respectfully submitted,

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1.   A method of computing, comprising:

at a processor in a storage network:

receiving a service request from a user of the storage network;

determining an amount of credit available on a local media for the user of the storage network;

implementing the service request at the processor when the amount of credit is sufficient to execute the service request; and

when the amount of credit is insufficient to execute the service request:

generating, in response to the received service request, a token request for a service token; and

transmitting the token request to a server communicatively connected to the storage network; and

at the server:

validating the token request;

transmitting to the processor a response to the validated token request; and

at the processor in the storage network:

invoking the service request when the response to the token request includes at least one service token.

2.   The method of claim 1, wherein the service request is generated by at least one of a user of a device in the storage network or by a processor communicatively connected to the storage network.

3.   The method of claim 1, wherein the service request comprises a request for at least one of a data mirroring service, a remote copy service, a back-up service, a recovery service, or a LUN extension service.

4.   The method of claim 1, wherein generating a token request comprises retrieving at least one account identifier for an account associated with a device in the storage network.

5.   The method of claim 4, wherein generating a token request comprises incorporating into the token request information identifying the service request.

6.   The method of claim 5, wherein validating the token request comprises validating the

at least one account identifier associated with the service request.

7.   The method of claim 5, wherein validating the token request comprises determining whether the account associated with the at least one account identifier comprises sufficient credit to receive a token.

8.   The method of claim 7, further comprising retrieving information from a third-party credit bureau.

9.   The method of claim 1, wherein the response to the token request comprises at least one of:

an account identifier;

an account balance;

a code, decipherable by the processor, granting or denying permission to invoke the service call; and

a software module, executable by the processor, for invoking the service call.

10.   The method of claim 1, further comprising updating account information at the processor in the storage network.

11.   The method of claim 1, wherein the response to the token request comprises a software module, executable by the processor, for invoking the service call.

12.   The method of claim 11, wherein the processor in the storage network:
       receives the response to the token request; and
       executes the software module to invoke the service request.

13.   The method of claim 11, wherein the processor maintains account information associated with one or more storage devices, and wherein the processor updates account information to reflect execution of the service request.

35.   A storage system, comprising:

a local controller comprising a processor an a memory module, wherein the memory module comprises logic instructions which, when executed by the processor, configure the processor to:

receive a service request from a user of the storage network;

determine an amount of credit available on a local media for the user of the storage network;

implement the service request at the processor when the amount of credit is sufficient to execute the service request; and

when the amount of credit is insufficient to execute the service request:

generate, in response to the received service request, a token request for a service token; and

transmit the token request to a server communicatively connected to the storage network; and

a remote server coupled to the local controller comprising a processor an a memory module, wherein the memory module comprises logic instructions which, when executed by the processor, configure the processor to:

validate the token request; and

transmit to the processor a response to the validated token request; and

at the processor in the storage network,

wherein the processor invokes the service request when the response to the token request includes at least one service token.

36.   The storage system of claim 35, wherein the service request is generated by at least one of a user of a device in the storage network or by a processor communicatively connected to the storage network.

37.   The storage system of claim 35, wherein the service request comprises a request for at least one of a data mirroring service, a remote copy service, a back-up service, a recovery service, or a LUN extension service.

38.   The storage system of claim 35, wherein the memory module on the local controller comprises logic instructions which, when executed by the processor, configure the processor to retrieve at least one account identifier for an account associated with a device in the

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storage network.

39.   The storage system of claim 35, wherein the memory module on the local controller comprises logic instructions which, when executed by the processor, configure the processor to incorporate into the token request information identifying the service request.

40.   The storage system of claim 35, wherein the memory module on the remote server comprises logic instructions which, when executed by the processor, configure the processor to validate the at least one account identifier associated with the service request.

41.   The storage system of claim 35, wherein the memory module on the remote server comprises logic instructions which, when executed by the processor, configure the processor to determine whether the account associated with the at least one account identifier comprises sufficient credit to receive a token.

42.   The storage system of claim 35, wherein the memory module on the remote server comprises logic instructions which, when executed by the processor, configure the processor to retrieve information from a third-party credit bureau.

43.   The storage system of claim 35, wherein the response to the token request comprises at least one of:

    an account identifier;

    an account balance;

    a code, decipherable by the processor, granting or denying permission to invoke the service call; and

    a software module, executable by the processor, for invoking the service call.

44.   The storage system of claim 35, wherein the memory module on the local controller comprises logic instructions which, when executed by the processor, configure the processor to update account information at the processor in the storage network.

45.   The storage system of claim 35, wherein the response to the token request comprises a software module, executable by the processor, for invoking the service call.

46.   The storage system of claim 45, wherein the memory module on the local controller comprises logic instructions which, when executed by the processor, configure the processor to:

    receive the response to the token request; and

execute the software module to invoke the service request.

47.   The storage system of claim 45, wherein the processor maintains account information associated with one or more storage devices, and wherein the processor updates account information to reflect execution of the service request.

Evidence Appendix

None

Related Proceedings Appendix

None